REMARKS

Introduction

Claims 1-5 are currently pending in the present application, with claims 1 and 3-5 having been amended herein. No new matter is presented by the claim amendments. It is submitted that claims 1-5 are allowable in view of the foregoing amendments and following remarks.

The Non-enablement rejection

Claims 1-5 have been finally rejected under 35 U.S.C. §112, first paragraph, as being non-enabling. In this regard, the Examiner sets forth two separate grounds for lack of enablement. First, it is asserted that because claim 1 recites processor readable instructions that implement a network status reporting level determination mechanism, disclosure of the program code is required by the statute. Second, it is asserted that there is a "remaining question" as to whether the specification provides enough information for those skilled in the art to make and use the invention without undue experimentation (which question is answered "no" by the Examiner).

As to the first stated ground for lack of enablement, Applicant respectfully disagrees with the position taken by the Examiner that a listing of program source code is required for enabling the recited claims. In this regard, it is initially noted that the Court of Appeals for the Federal Circuit has concluded unequivocally that disclosure of a code listing is unnecessary when a programmer of reasonable skill could write a version of the program with reasonable effort. See Northern Telecom Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990). Since the burden of proof lies with the Patent Office in establishing a prima facie case, it is submitted that the mere statement by the Examiner that a program listing is required simply because the element "processor readable instructions" is recited in the claim fails to carry the burden of showing that a programmer of reasonable skill in the art would not be able to write a version of the processor readable

instructions so as to implement a network status reporting level determination mechanism. Since this secondary inquiry into the competence of a programmer of reasonable skill in the art is essentially analogous to the second stated ground for lack of enablement, it is submitted that in reality the first ground of rejection is spurious, and that there is only one legally permissible basis for the enablement rejection, namely, the asserted ground that the skilled practitioner would not be able to practice the invention based on the disclosure in the specification without **undue experimentation**.

With regard to this asserted ground for lack of enablement, the Final Office Action indicates that:

> [T]he specification fails to disclose **how** to determine a level of detail to report the network status to [the] network operations console based on at least one of [a] user request and a predetermined allocation of bandwidth for use in reporting network status wherein regardless of the user request, the level of detail is limited to a maximal level permitted by available bandwidth as claimed. Figure 2 merely shows several rectangular boxes labeled as daemon, manager, switches and consoles interconnected by lines. The description of Figure 2 in the specification does not provide any more information than what is already shown in Figure 2. A skilled programmer would not be able to transform the hardware connections shown in Figure 2 to instructions [that] when executed would control a processor to operate in a manner as claimed.

In the previously-filed response to the first Office Action, it was noted that Figure 2 and the accompanying text of the present application explain the interrelationship among the various elements of the network system (i.e., the network operations consoles, the flow control daemon, the real time status manager, and the real time database daemon) such that one of ordinary skill in the art would be able to arrive at the claimed subject matter without **undue experimentation**. In particular, it was noted that the specification indicates that the flow control daemon acts as a filter for

network status information, gathering a range of information from the real time manager and database, but only providing the most essential information, or specifically requested information, to the network operation consoles so as not to exceed bandwidth limitations.

Moreover, the specification provides further detailed description as to how the level of detail of reporting is determined. For example, the specification indicates that:

> [T]he number and sizes of messages that are allocated to network status information between a flow control daemon 15 and a network operations console 16A, 16B ***is a configurable quantity***, that can be specified, for example in a configuration file resident on the workstation on which the flow control daemon resides. In other embodiments, the quantity is set via a local or remote (e.g., Web) graphical interface or by reading from a database. In yet another embodiment, the network operations console 16A, 16B transmits connection information to the flow control daemon 15 which aids in determining how much bandwidth on the connection L1 to allocate to network status messages. (Specification, page 8, lines 26-32 (emphasis added)).

As further explained in the specification, the flow control daemon includes a network status reporting mechanism that "determines, based on available bandwidth and the number of check boxes 420 [configured at the user interface], the amount of information that should be reported back to the network operating tool user interface 22." (Specification, page 9, lines 1-3). The reporting mechanism can alter the level of reporting according to bandwidth requirements by providing "the highest level of detail that can be accommodated without exceeding the bandwidth allocated to network status information for the particular consoles 16A, 16B." (Id., lines 9-12). As also explained in the specification, "the system limits the number of ports whose statuses can be displayed . . . such that the bandwidth of the link L1 between the flow control daemon 15 and the console 16 is not exceeded.

The system can then devote the remaining bandwidth not used . . . for additional summary information." (Id., lines 16-19).

These sections of the specification clearly explain how the level of detail reported is determined by: i) user configuration, which determines such information as the particular switches for which information is desired; and also by ii) bandwidth preservation logic at the flow control daemon which automatically modifies the reported level to higher levels of abstraction, i.e., lesser degrees of detail, where bandwidth resources are scarce. Figures 17 to 19 illustrate examples of varying, hierarchical degrees of report detail (medium, high and low levels, respectively). In Figure 17, summary information is provided for every port of each network switch in the span being monitored. In Figure 18, detailed information is provided for each of the ports, and in Figure 19, for a number of switches, no port information is provided, but only summary information about the switch as á whole (e.g., for switches 1 and 4).

In view of the above-noted descriptions found in the specification, it is submitted that programmers of skill in the art could program, without undue experimentation, user interface configuration functionality (for example, using Visual Basic in a Windows-based operating system environment) for setting user-requested levels of report detail that operate in concert with fail-safe algorithms residing at the flow control daemon which override or modify user-requested levels to accommodate bandwidth requirements.

The Examiner has made conclusory assertions, but the Examiner has offered no concrete evidence that undue experimentation would be required to achieve the claimed invention. Furthermore, Applicant notes that the relevant factors to be considered in determining whether a specification satisfies the enablement requirement include, but are not limited to, the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working

examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See M.P.E.P. § 2164.01 (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the examiner's analysis must therefore "**consider all the evidence related to each of these factors**" so that any nonenablement conclusion "must be based on the evidence as a whole." (See MPEP § 2164.01). It is respectfully submitted that the Examiner has not addressed these required factors in a substantive manner.

In summary, for the foregoing reasons, it is respectfully submitted that a prima facie case of non-enablement has not been established with respect to claim 1-5. In view of the foregoing, withdrawal of the rejection of claims 1-5 under the enablement clause of §112, first paragraph, is respectfully requested.

Obviousness Rejection

Claims 1-5 have been finally rejected under 35 U.S.C. §103(a) as being unpatentable over Pendleton, U.S. Patent No. 5,982,753, in view of Kavner, U.S. Patent No. 6,430,607.

Initially, Applicant disagrees with the Examiner's statement made in the Final Office Action that "Applicants agree on the Examiner's interpretation of the Pendleton reference." Applicant does not admit, and has not admitted, to any "agreement" regarding interpretation of the Pendleton reference.

Independent claims 1, 3, 4 and 5 recite determining a level of detail or reporting level to report said network status to said network operations console based on a user request and a predetermined allocation of bandwidth for use in reporting network status.

It was previously acknowledged by the Examiner in the first Office Action that Pendleton does not disclose determining a reporting level to

report said network status based on a predetermined allocation of bandwidth for use in reporting network status.

In the Final Office Action, the Examiner asserts that the Kavner reference discloses "pre-allocation of sufficient bandwidth for transmitting message stream [wherein] the pre-allocated bandwidth limits the level of details." Without passing judgment as to the accuracy of this statement by the Examiner, it is noted that allocation of different bandwidths for data transmission for differing data services (such as MAIL, CHAT and VIDEO services) does not entail making a determination as to the level of detail of reporting information for a given service based on bandwidth considerations.

As noted in the Applicant's previous response, while the Kavner patent refers to bandwidth allocations for client/server or client/gateway interactions, these allocations have nothing to do with changing a reporting level of a report on network status based on a predetermined allocation of bandwidth, as recited in the claims. In Kavner, a client processor includes an "MCP" (Microsoft Network Procedure Call) layer that uses a service priority table to allocate segment lengths to different segments for various on-line services, e.g., CHAT, MAIL, VIDEO GAMES, etc. (Kavner, col. 46, line 17 to col. 47, line 19). Similarly, Kavner discloses making different bandwidth allocations to client-to-Gateway communication versus Gateway-to-client communication. While these bandwidth allocation schemes allocate different data for the respective services, no decision as to a level of detail of a report is made. In other words, Kavner does not disclose varying the amount of information gathered and displayed in a report based on bandwidth requirements and user request. In plain terms, neither Pendleton nor Kavner discloses or suggests the following decision making process: "X status information and Y bandwidth are provided. Although it would be most helpful to provide the total X status information, in view of the fact that there is only Y bandwidth available, it is determined to provide a Z level of detail with regard to the X information, which level of detail provides a certain percentage of X information."

In light of the above, it is submitted that the combination of Pendleton and Kavner, whether taken individually or in combination, fails to disclose or suggest determining a level of detail to report said network status to a network operations console based on a user request and a predetermined allocation of bandwidth for use in reporting network status, as recited in independent claims 1, 3, 4 and 5. Withdrawal of the final rejection of claims 1-5 under 35 U.S.C. §103(a) is therefore respectfully requested.

CONCLUSION

Applicant respectfully submits that the present invention is new, non-obvious, and useful. Reconsideration and allowance of pending claims 1-5 is respectfully requested.

Respectfully submitted,

KENYON & KENYON

Dated: 12/4, 2003 By: _____

Jong H. Lee
Reg. No. 36,197

One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO.: 26646